

Docket No.: 377/9-1616


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gianluigi GAMBERINI Conf. No. 9685
Serial No.: 09/989,225 Group Art Unit: 3721
Filing Date: November 20, 2001 Examiner: John Roger Paradiso
For: DEVICE FOR PACKAGING ROLLS OF WEB MATERIAL
IN AN AUTOMATIC PACKAGING MACHINE

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO FINAL OFFICE ACTION

Sir:

In response to the Office Action dated April 2, 2004, the applicant hereby respectfully traverses the examiners grounds for rejection.

Claims 1-19 were rejected as being obvious over Cinotti, U.S. Patent No. 5,331,788, in view of Isani, U.S. Patent No. 5,600,935. The applicant believes the examiner has improperly rejected the claims by creating a hindsight reconstruction, modifying the primary reference, Cinotti, in view of Isani, without any teaching or suggestion to do so, instead using the applicants disclosure as a guide to pick only those components that would render the invention obvious while ignoring what the reference, as a whole would fairly suggest to one skilled in the art.

It is not within the framework of 35 USC §103 to pick and choose from the prior art only so much as will support a holding of obviousness to the exclusion of other parts necessary for a full appreciation of what the prior art teaches or suggests, as hindsight is not the test. In re Wesslau, 353 F.2d 238 (CCPA 1965). "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure". In re Dow Chemical Co., 837 F.2d